



KCC 4742 (K-C 14,442A)
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of David W. Koenig, et al.
Serial No. 10/028,752
Filed December 20, 2001
Confirmation No. 2567
For ABSORBENT ARTICLE
Examiner: Catharine L. Anderson

Art Unit 3761

February 2, 2006

PETITION FOR APPLICATION FOR PATENT
TERM ADJUSTMENT PURSUANT TO 37 CFR § 1.705(b)

TO THE COMMISSIONER OF PATENTS,
SIR:

In response to the Notice of Allowance dated November 2, 2005, in the above-referenced patent application, applicants respectfully request reconsideration of the patent term adjustment determination. Pursuant to 37 CFR § 1.705(b) and/or (d), applicants submit the following statement of facts in support of this request for reconsideration.

The application was filed on December 20, 2001. On April 9, 2003, the first and second supplemental information disclosure statements were filed. The first Office action was mailed on June 23, 2003, which is one-hundred twenty-three (123) days after the fourteen (14) month due date for the mailing of a first Office action on the merits. The response to the first Office action was filed on September 17, 2003, which is within the three (3) month shortened statutory period for response. A fourth supplemental information disclosure statement was filed on October 28, 2003, which is forty-one (41) days after the response to the first Office action was filed and thirty-five (35) days after the three (3) month shortened statutory period for response.

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to an Office action.¹ The second Office action was mailed on January 15, 2004, which is within the four (4) month period for reply by the Office. The response to the second Office action was filed on April 15, 2004, which is within the three (3) month shortened statutory period for response. The third Office action was mailed on July 2, 2004, which is within the four (4) month period for reply by the Office. The response to the third Office action was filed on October 4, 2004. A sixth supplemental information disclosure statement was filed on January 6, 2005, which is ninety-four (94) days after the response to the third Office action was filed.² The fourth Office action was mailed on May 18, 2005, which is one-hundred three (103) days after the four (4) month period for reply by the Office. The response to the fourth Office action was filed on August 15, 2005, which is within the three (3) month shortened statutory period for response. An eighth supplemental information disclosure statement was filed on October 4, 2005, which is fifty (50) days after the response to the fourth Office action was filed, and forty-seven (47) days after the three (3) month shortened statutory period for response to an Office action. The Notice of Allowance was mailed on November 2, 2005, which is within the four (4) month period for reply by the Office, and indicated that

¹According to PAIR, this information disclosure statement was filed on October 30, 2003. However, this fourth supplemental information disclosure statement was actually filed on October 28, 2003, as evidenced by the certificate of mailing submitted therewith.

²According to PAIR, this information disclosure statement was filed on January 10, 2005. However, this sixth supplemental information disclosure statement was actually filed on January 6, 2005, as evidenced by the certificate of mailing submitted therewith.

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the subject application was entitled to a patent term adjustment of thirty-three (33) days. On January 25, 2006, a letter was filed with the Patent Office resending the first and second supplemental information disclosure statements, and requesting the Examiner initial and return these supplemental information disclosure statements.³

Based upon the above-recited facts, the delay on the part of the Office was two-hundred twenty-six (226) days. According to the Patent Application Information Retrieval (PAIR) database regarding the instant application, the delay on the part of the Office is reduced by one-hundred ninety-three (193) days of applicant delay, to give a total patent term adjustment of thirty-three (33) days. According to PAIR, the applicant delay consists of:

1) forty-three (43) days, stretching from the day after the initial response to the first Office action was filed to the day the fourth supplemental information disclosure statement was filed;⁴

³This letter was merely resending the first and second supplemental information disclosure statements at the suggestion of the Office. Since both the first and second supplemental information disclosure statements were timely filed on April 9, 2003, applicants submit that this letter does not constitute a failure of applicants to engage in reasonable efforts to conclude processing or examination of an application under 37 C.F.R. §1.704(c)(10), submission of a paper after notice of allowance.

⁴As noted above, according to PAIR, the fourth supplemental information disclosure statement was filed on October 30, 2003. However, the fourth supplemental information disclosure statement was actually filed on October 28, 2003. As such, there was actually only 41 days from the date after the initial response to the first Office action was filed to the date the fourth supplemental information disclosure statement was filed.

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2) two days, stretching from the day after the three (3) month shortened statutory period for response to the third Office action to the date the response to the third Office action was filed;

3) ninety-eight (98) days, stretching from the day after the response to the third Office action was filed to the day the sixth supplemental information disclosure statement was filed;⁵ and

4) fifty (50) days, stretching from the day after the response to the fourth Office action was filed to the day the eighth supplemental information disclosure statement was filed.

With regard to delays 1), 3), and 4) above, it appears the Office is considering the fourth, sixth, and eighth supplemental information disclosure statements to be supplemental replies to the first, third, and fourth Office actions, respectively. As established in 37 C.F.R. §1.704(c)(8), submission of a supplemental reply after a reply has been filed is a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. However, applicants respectfully submit that the fourth, sixth, and eighth supplemental information disclosure statements are not supplemental replies, as mentioned in 37 C.F.R. §1.704(c)(8), but rather, are preliminary papers, as mentioned in 37 C.F.R. §1.704(c)(6).

⁵As noted above, according to PAIR, the sixth supplemental information disclosure statement was filed on January 10, 2005. However, the sixth supplemental information disclosure statement was actually filed on January 6, 2005. As such, there was actually only 94 days from the date after the initial response to the third Office action was filed to the date the sixth supplemental information disclosure statement was filed.

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Initially, applicants note that none of the supplemental information disclosure statements at issue were submitted for purposes of supplementing an Office action response. Rather, these supplemental information disclosure statements were submitted merely to report references of which applicants had become aware, in compliance with applicants duty of disclosure under 37 C.F.R. 1.97 and 1.98. It is thus respectfully submitted that applicants should not be penalized by losing patent term, simply because applicants were attempting to comply with the duty of disclosure under 37 C.F.R. 1.97 and 1.98.

Instead of a supplemental reply as mentioned in 37 C.F.R. §1.704(c)(8), it is submitted that the fourth, sixth, and eighth supplemental information disclosure statements are actually preliminary papers, as mentioned in 37 C.F.R. §1.704(c)(6). As established in 37 C.F.R. §1.704(c)(6), submission of a preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

In the instant case, none of the supplemental information disclosure statements were submitted less than one month before the mailing of an Office action or notice of allowance or required the mailing of a supplemental Office action or notice of allowance. For instance, the fourth supplemental information disclosure statement was filed on October 28, 2003, which is more than one month before the mailing of the second Office action on January 15, 2004. The sixth supplemental information disclosure statement was filed on January 6, 2005, which is more than one

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month before the mailing of the fourth Office action on May 18, 2005. Although the eighth supplemental information disclosure statement, filed on October 4, 2005, was filed less than one month before the mailing of the notice of allowance, mailed November 2, 2005, the filing of the eighth supplemental information disclosure statement did not require the mailing of a supplemental notice of allowance, as a copy of the eighth supplemental information disclosure statement initialed by the Examiner was received with the notice of allowance. As such, applicants submit that there is no applicant delay as a result of filing the fourth, sixth, and eighth supplemental information disclosure statements.

With respect to applicant delay 2), described above, the three (3) month shortened statutory period for response to the third Office action was October 2, 2004, but the response to the third Office action was filed on October 4, 2004. However, October 2, 2004 fell on a Saturday. As stated in MPEP §710.05 and 35 U.S.C. §21(b), when the day for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday, the action may be taken, or the fee paid, on the next succeeding day that is not a Saturday, Sunday, or Federal holiday. Since the three (3) month shortened statutory period for response to the third Office action fell on a Saturday (i.e., October 2, 2004), applicants had until the next succeeding business day (i.e., Monday October 4, 2004) to file a timely response. As such, applicants submit that there is no applicant delay resulting from the filing the response to the third Office action on October 4, 2004.

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In light of the foregoing, applicants believe that the patent term adjustment should be 226 days (representing the total amount of Office delay).

A terminal disclaimer was filed in this application on August 15, 2005, as part of the response to the fourth Office action. In the terminal disclaimer, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,891,079, was disclaimed.⁶ As stated in 35 U.S.C. §154(b)(2)(B), "No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer."

According to PAIR, U.S. Patent No. 6,891,079 was filed on December 20, 2001, and is subject to two-hundred thirty (230) days of patent term adjustment. The present application was also filed on December 20, 2001. Therefore, the present application is not entitled to an adjustment of patent term longer than that received in U.S. Patent No. 6,891,079, i.e., 230 days. Since the patent term adjustment for the instant application (i.e., 226 days) is less than that received in U.S. Patent No. 6,891,079 (i.e., 230 days), it is submitted that the instant application is

⁶The terminal disclaimer stated, in part: "The owner, Kimberly-Clark Worldwide, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,891,079."

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entitled to the full 226 days of patent term adjustment, even though a terminal disclaimer was filed.

The Commissioner is hereby authorized to charge \$200 to pay for the fee under 37 C.F.R. §1.18(e), and to charge any under payment or credit any overpayment to deposit account No. 19-1345.

Respectfully submitted,



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